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EXAMINER

NGUYEN, HAI V

ART UNIT

PAPER NUMBER

2142

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/716,415

Applicant(s)

TAKEDA ET AL.

Examiner

Hai V. Nguyen

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,5 and 7-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5 and 7-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 08/25/2006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This Office Action is in response to the communication received on 05 May 2006.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05 May 2006 has been entered.

3. Claims 2, 3, 6 are cancelled.
4. Claims 1, 4, 5, 7-22 are presented for examination.

#### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 17-18, 5-16, 22 are rejected under 35 U.S.C. 101 because the claim 1 recite the output system comprising the elements of "a managing section; a search section; a notifying section; a distinguishing section; a selecting section" in claims 1, 17, 18, 21 and of "an address managing section; a search section; an address notifying section; a receiving section; a distinguishing section; a converting section; an information managing section; a separating section; an individual managing section; a restriction section; a restriction notifying section; a deleting section; a virus processing section; a report preparing section; a report print control section" in claims 5, 9-15,

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which when read in light of specification amounts to nothing more than computer software void of computer readable medium. See MPEP 2106(IV)(B)(1).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mitsuya JP11312068** in view of **Fujisawa et al. JP # 11312065 A**.

9. As to claim 1, Mitsuya discloses an information output system comprising:  
a managing section for managing a mail address for each output printing apparatus of an output printing apparatus group (*the printer server 31 in figure 10-12 manages and stores the correspondence table between a plurality of email addresses and the associated printer ports, [0082]-[0090]*);

However Mitsuya does not explicitly disclose a search section for searching the output printing apparatus group managed by the managing section for one candidate output printing apparatus or a plurality of candidate output printing apparatuses in response to a search request having search conditions from a transportable terminal apparatus; a notifying section for notifying said transportable terminal apparatus of the mail address of said candidate output printing apparatus or the plurality of candidate output printing apparatuses found in a search by the search section, wherein the

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transportable terminal apparatus issues an electronic mail to a destination mail address of a designated output printing apparatus, and wherein the destination mail address is based upon the mail address of said candidate output printing apparatus or the plurality of candidate output printing apparatuses provided by the notifying section; and a distinguishing section for distinguishing the designated output printing apparatus from said output printing apparatus group based on the destination mail address of the electronic mail issued from said transportable terminal apparatus, wherein said designated output printing apparatus produces printed output of outputting information included in the electronic mail issued from said transportable terminal apparatus, and wherein said managing section further manages performance information for each of said output printing apparatuses and manages installation position information for each of said output printing apparatuses, and said search section searches for said one candidate output printing apparatus or the plurality of candidate output printing apparatuses based on said performance information, and based on said installation position information.

In the same field of endeavor, Fujisawa discloses in figure 6 that search conditions is inputted by the user and the search of a printer information database is performed and the printer which has required function can be chosen ([0038]-[0047]; [0057]-[0066]).

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Fujisawa's teachings of the program of printer search method with the teachings of Mitsuya, for the *purpose of*

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*effectiveness to the user looking for a print shop with the printer of the function which he wants to use (Fujisawa, [0066]).*

10. Claim 19 corresponds to the method claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

11. Claim 20 corresponds to the computer readable medium claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

12. Claims 4, 16-18 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mitsuya-Fujisawa** as applied to claim 1 above, and further in view of **Eldridge et al. US patent # 6,421,716 B1**.

13. As to claim 4, Mitsuya-Fujisawa does not explicitly disclose an accounting processor for performing accounting processing before outputting the information included in said electronic mail.

Eldridge disclose printing cost (*Eldridge, printing cost, col. 13, lines 1-8*).

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Eldridge's teachings of printing cost with the teachings of Mitsuya-Fujisawa, for the *purpose of charging for printing service (Eldridge, printing cost, col. 13, lines 1-8)*.

14. Claim 16 introduces identical limitation of claim 4; therefore, it is rejected under the same rationale as in claim 4.

15. Claim 17 corresponds the system claims of claims 1, 4; therefore, it is rejected under the same rational as in claims 1, 4.

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16. Claim 18 introduces identical limitation of claim 4; therefore, it is rejected under the same rationale as in claim 4.

17. Claim 21 corresponds to the system claim of claims 1, 4; therefore, it is rejected under the same rationale as in claims 1, 4.

18. As to claim 22, Mitsuya-Fujisawa-Eldridge discloses wherein the transportable terminal apparatus is capable of sending and receiving electronic mail (*Eldridge, Fig. 1, PDA 118*).

19. Claims 5, 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mitsuya-Fujisawa** and further in view of **Larson et al. US patent # 7,028,102 B1**.

20. As to claim 5, Mitsuya discloses an information output system comprising:

a printer group comprising a plurality of printers; and an address managing section for managing a mail address for each of said printers (Figures 10-12, printers 5);

However Mitsuya does not explicitly disclose a search section for searching said printer group managed by the managing section for one candidate printer or a plurality of candidate printers in response to a search request having search conditions from a client; a notifying section for notifying said client of the mail address of said candidate printer or the plurality of candidate printers found in a search by the search section, wherein client issues an electronic mail to a destination mail address of a designated printer, and wherein the destination mail address is based upon the mail address of said candidate printer or the plurality of candidate printers provided by the notifying section; a second server comprising a receiving section for receiving the electronic mail issued from said client, a distinguishing section for distinguish the designated printer from said

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printer group based on the destination mail address of the electronic mail; and wherein said information managing section for managing performance information and installation position information for each of said printers; and an information notifying section for notifying said client of at least one of the performance information and the installation position information with respect to said one candidate printer or the plurality of candidate printers.

In the same field of endeavor, Fujisawa discloses in figure 6 that search conditions is inputted by the user and the search of a printer information database is performed and the printer which has required function can be chosen ([0038]-[0047]).

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Fujisawa's teachings of the program of printer search method with the teachings of Mitsuya, for the *purpose of effectiveness to the user looking for a print shop with the printer of the function which he wants to use (Fujisawa, [0066])*.

However, Mitsuya-Fujisawa does not explicitly disclose a converting section for converting information included in said electronic mail in accordance with said designated printer and said designated printer prints output of said converted information.

Larson discloses that the document conversion means 218 uses a portion of the printer specification containing data for selecting an appropriate device driver 220 to determine what device driver 220 to use for creating the print file. The conversion means now utilizes the selected application 224 and the selected device driver 220 to



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convert the requested document to a printer file that the target printer can use (*Larson, col. 9, lines 32-42*).

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Mitsuya-Fujisawa's teachings with the teachings of Larson, for the *purpose of appropriate printing according to the printer specification (Larson, col. 9, lines 5-11)*.

21. As to claim 7, Mitsuya-Fujisawa-Larson discloses wherein the electronic mail is utilized to perform communication between said client and said first server (*Mitsuya, [0082]-[0090]*).

22. As to claim 8, Mitsuya-Fujisawa-Larson discloses an authentication apparatus (*Larson, Fig. 11, path 908, col. 12, lines 12-64*) for performing user authentication prior to print processing of said converted information in said designated printer.

23. As to claim 9, Mitsuya-Fujisawa-Larson discloses wherein said second server further comprises: a separating section for separating said electronic mail into a plurality of mail elements; and an individual managing section for individually managing said respective separated mail elements, and said information to be printed corresponds to one mail element (*Mitsuya, [0082]-[0090]*).

24. As to claim 10, Mitsuya-Fujisawa-Larson discloses wherein said second server further comprises: a storing section in which the information constituting said electronic mail is stored (*Mitsuya, [0082]-[0090]*); a monitor section for monitoring an empty capacity of said storing section (*Mitsuya, [0082]-[0090]*); and a restricting section for

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restricting reception of a print request in accordance with lack of capacity of said storing section (*Mitsuya, [0082]-[0090]*).

25. As to claim 11, Mitsuya-Fujisawa-Larson discloses wherein said second server further comprises a restriction notifying section for notifying said client of reception restriction when the reception of said print request is restricted (*Mitsuya, [0082]-[0090]*).

26. As to claim 12, Mitsuya-Fujisawa-Larson discloses wherein said converting section converts the information included in said electronic mail to a PDL file in accordance with said designated printer (*Larson, col. 9, line 3 – col. 10, line 45*).

27. As to claim 13, Mitsuya-Fujisawa-Larson discloses a storing section for storing said PDL file; and a deleting section for deleting the PDL file stored in said storing section when a predetermined condition is satisfied (*Larson, col. 9, line 3 – col. 10, line 45*).

28. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mitsuya-Fujisawa-Larson** discloses as applied to claim 5 above, and further in view of **Chen et al. US patent # 5,832,208**.

29. As to claim 14, Mitsuya-Fujisawa-Larson does not explicitly disclose executing a virus check with respect to said electronic mail.

Chen discloses scanning respective emails for viruses and removing viruses (*col. 5, line 2 – col. 6, line 4*).

Accordingly, it would have been obvious to one of ordinary skill in the networking

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art at the time the invention was made to have incorporated Mitsuya-Fujisawa-Larson's teachings with the teachings of Chen, for the *purpose of controlling viruses in emails* (Chen, col. 5, line 2 – col. 6, line 4).

30. As to claim 15, Mitsuya-Fujisawa-Larson-Chen discloses a report preparing section for preparing a virus check report when it is judged by said virus check that a virus exists; and a report print control section for performing a control to allow said virus check report to be printed instead of the printing of the information included in said electronic mail in said designated printer when it is judged that said virus exists (Chen, col. 5, line 2 – col. 6, line 4).

31. Further references of interest are cited on Form PTO-892, which is an attachment to this action.

32. Yacoub's claimed invention is directed to the user sending the print job request with preferences (e.g., quality, speed, color...; location nearby) to the print server and the print server determines and selects the appropriate printer to print the job (Abstract, Fig. 2, col. 4, line 27 – col. 6, line 48).

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### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 571-272-3901. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hai V. Nguyen  
Examiner  
Art Unit 2142



ANDREW CALDWELL  
SUPERVISORY PATENT EXAMINER